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09/923,675	08/06/2001	Michael W. Wood	MOODY 20	1529
24258	7590	07/08/2004	EXAMINER	
JOHN EDWARD ROETHEL 2290 S. JONES BLVD. #100 LAS VEGAS, NV 89146			MARKS, CHRISTINA M	
			ART UNIT	PAPER NUMBER
			3713	

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/923,675  
Filing Date: August 06, 2001  
Appellant(s): WOOD ET AL.

John Edward Roethel  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 May 2004.

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**(1) Real Party in Interest**

A statement identifying the real party in interest has not yet been assigned but is under contract to be assigned to Action Gaming Inc. is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is partially agreed with; however, it is deficient as it lacks citing page and line numbers from the specification. For the convenience of the Board, the Examiner has added them below:

Appellants' invention relates to a video draw poker game that includes a bonus feature (*page 6, lines 4-5*) determined by the cards that are dealt on the initial five card hands of the video poker game (*page 6, lines 9-11*). The regular video draw game is played in the conventional manner (*page 6, lines 12-17*).

This bonus feature game plays along with the video draw poker game (*page 11, lines 14-22*). The bonus game involves establishing a predetermined arrangement of cards that the player must match over the course of consecutive rounds of the video draw poker game (*page 11, lines 8-22*). Depending on how many consecutive rounds of the video draw poker game

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must be played in order for the player to match the predetermined arrangement of cards, the player may win a bonus award (*page 13, lines 12-15*).

As each round of the video draw poker game is played, the initial five cards that are dealt are compared to the predetermined arrangement of cards that the player must match (*page 12, lines 4-13*). The amount of a bonus award that is paid to the player is based on the number of consecutive rounds that it takes for the player to match all of the predetermined arrangement of cards (*Table 1*).

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The appellant's statement of the grouping of claims in the brief is correct and agreed upon.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,957,774	HOLMES et al	09-1999
6,089,976	SCHNEIDER	07-2000
5,935,002	FALCIGLIA	08-1999

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 19 November 2003 and is repeated here for convenience.

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Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, Jr. et al. (US Patent No. 5,957,774) in view of Schneider (US Patent No. 6,089,976) further in view of Falciglia (US Patent No. 5,935,002).

Holmes, Jr. et al. disclose a method of playing a video poker game having a bonus award associated with the poker game (Abstract). A predetermined arrangement of five cards (FIG 1-A, reference 220) is established as a winning bonus award and is thus used as the player's matching cards for the game (Column 3, lines 45-51). Holmes, Jr. et al. also contemplate the use of the predetermined arrangement of cards based upon the Royal Flush, as the Royal Flush typically represents the highest payout (thus has the least likelihood) for poker (Column 1, lines 57-67; Column 2, lines 14-17). The player is then dealt a first initial five-card hand (Column 3, line 47) and it is determined whether any of the first initial five cards match any of the predetermined cards (Column 3, lines 48-51). After the initial five cards are analyzed to determine if a win has occurred on the deal, the player is then allowed to play out the first initial five card hand according to the convention rules of poker (Column 3, lines 7-12). Holmes, Jr. et al. also disclose that the player must make a wager in order to be eligible to participate in the game (Column 1, lines 24-26).

Holmes, Jr. et al. do not disclose noting the matched cards as they occur or continuing to deal subsequent hands and allowing the player to play out each of the subsequent hands in order to continue trying to match cards with the predetermined arrangement.

However, Schneider et al. discloses a bonusing method wherein a player plays multiple rounds of a game in an attempt to achieve a match in order to win a secondary award (Abstract). Unlike Holmes, Jr. et al., the quest to match does not end after one hand and the process continues until an actual match is achieved (Abstract). The player receives a number of selections that continue until a match occurs at which time the match is noted by displaying it to

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the player (Abstract). When a match has been made, it will be determined the bonus award which will be awarded to the player (Column 6, lines 11-23). Further, using the match method of Schneider et al., an advantage is that the player has two opportunities to win (Column 3, lines 40-45) as well as increased opportunities to achieve a match.

It would have been obvious to one of ordinary skill in the art to apply the teachings of Schneider et al. to the system of Holmes, Jr. et al. Holmes, Jr. et al. allow the player only one opportunity to make a match, thus limiting the excitement and continued anticipation associated with the game. Alternatively, Schneider et al. allows a player to continue to attempt to make a match until one is actually made. One of ordinary skill in the art would be motivated to make this incorporation in order to provide the player with two opportunities to win, as taught by Schneider et al. as well as increase the player enjoyment and anticipation that would be associated with multiple opportunities to make a match in a bonus environment. By limiting the hand to only one try, as Holmes, Jr. et al. does, players could quickly become discouraged, as the actual chance of achieving all the matches in one hand is very low. Thus, by allowing the matching game of Holmes, Jr. et al. to occur until a match occurs, as taught by Schneider et al., the player would feel a greater amount of excitement and encouragement at the ability to continue play until an actual match occurs. Otherwise, players may just give up at the seemingly impossible task of matching all cards in one try.

However, in application of the teachings of Schneider et al. to Holmes et al., there is no disclosure as to how the bonus award would be calculated. In Holmes et al., the bonus award is given if the hand is matched and is not given if the hand is not matched. In Schneider et al., the bonus is given upon the occurrence of a match. One of ordinary skill in the art would understand that both of these functions of awarding would not be realistic in the combination of the two references as the multiple chances of Schneider et al. would not be conducive with an

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award only on one hand, as disclosed by Holmes, Jr. et al. Likewise, automating an award based on the match would not be conducive, as the player would be matching cards, not values.

Falciglia teaches of a game where the player makes an attempt to match the indicia chosen by the machine to preset indicia. The goal of the game is thus to make the desirable matches in order to obtain an award. Falciglia also teaches of basing the award received in the secondary game on the number of tries that it took for all of the predetermined arrangement of criteria to be matched (Column 6, lines 11-23). These payouts are based on a winnings schedule that provides a balance between winning, losing and investing for each spin (Column 6, lines 11-13).

Regarding claim 5, Falciglia does not disclose the exact payable as claimed; however, it is notoriously well known in the art to adjust pay tables for a variety of reasons including attempts to attract players with high payouts and payouts that would allow the player to perceive a greater chance of winning an award. It would have been obvious to one of ordinary skill in the art to do so and make adjustments to pay tables as long as the payable keeps the appropriate house advantage while remaining fair to the player and provide a proper balance between winning, losing, and investing for each spin as disclosed as desirable for a winnings schedule by Falciglia.

Further, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the payout teachings of Falciglia into the system of Holmes, Jr. et al. in view of Schneider et al. in order to base the award on the number of hands required to obtain a match. The flaws in the payout methods of Holmes, Jr. et al. in combination of Schneider have been identified above. By incorporating a payout associated with multiple chances for the player to accumulate a win and using a payable based upon the number of chances needed to achieve the winning hand, as taught by Falciglia, the method of Holmes, Jr. et al. in view of

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Schneider et al. would achieve a payable that would be desirable to the combination wherein the payout would not be associated with the match, but the amount of turns taken to acquire the match in order to obtain a winnings schedule that provides a balance between winning, losing and investing for each spin (Column 6, lines 11-13) as disclosed as desirable by Falciglia. Thus the incorporation of the teachings of Falciglia would work to correct the improbable payouts associated with Holmes, Jr. et al in view of Schneider et al. thus motivating a skilled artisan to incorporate such a feature.

**(11) Response to Argument**

Appellant begins their presentation by summarizing the prior art of record and presents their opinion of the Examiner's contentions regarding the references. Next, the Appellant attacks Schneider as requiring a qualifying event to get to the bonus round and always awarding the player and award. The Appellant then sets forth that Falciglia does not continue until the player matches all of the locations and then further submits Falciglia to be non-analogous to the art. The Appellant summarizes their presentation by stating that the Falciglia reference and the Schneider reference teach away from each other.

In response to the Appellant's argument that Schneider requires a qualifying event to the bonus round and always awards the player, the Examiner contends such assertions are not of merit to the basis of the rejection. The reliance upon Schneider is based upon the fact that Schneider et al. discloses a bonusing method wherein a player plays multiple rounds of a game in an attempt to achieve a match in order to win a secondary award (Abstract). Unlike Holmes, Jr. et al., the quest to match does not end after one hand and the process continues until an actual match is achieved (Abstract). The player receives a number of selections that continue until a match occurs at which time the match is noted by displaying it to the player (Abstract). When a match has been made, it will be determined the bonus award which will be awarded to



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the player (Column 6, lines 11-23). Further, using the match method of Schneider at al., an advantage is that the player has two opportunities to win (Column 3, lines 40-45) as well as increased opportunities to achieve a match. The argument regarding how the player enters the bonus round or the awards achieved there are not coterminous with the rejection as presented. These arguments are not directed towards that which Schneider is used, as a means to allow a player multiple chances in a bonus round and thus are not applicable to the manner in which Schneider was used.

In response to the Appellant's argument that Falciglia does not continue until the player matches all of the locations, the Examiner contends that such assertions are not of merit to the basis of the rejection. The reference of Schneider was used to submit such a feature as obvious to Holmes et al. The Examiner never contended that Falciglia was to be used as a teaching for such, and thus the argument that Falciglia does not comprise such a feature is not convincing as it is not coterminous to the manner in which Falciglia was used. For the record, Falciglia has its basis in supporting the limitation of basing the award received in the secondary game on the number of tries that it took for all of the predetermined arrangement of criteria to be matched (Column 6, lines 11-23). These payouts are based on a winnings schedule that provides a balance between winning, losing and investing for each spin (Column 6, lines 11-13). The Examiner has never made a contention that the purpose of Falciglia is to allow the player to continue play until a match occurs, but as a teaching regarding basing payouts on the number of hands it takes to establish a win.

In response to the Appellant's contention of the Falciglia reference being non-analogous, the Examiner respectfully disagrees. First, bingo and keno are analogous art to one of ordinary skill in the art as both are representative of random processes that are presented to the user in order for the user to hope to make a match with a predetermined combination in order to

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achieve an award based on a set number of rules. Second, the Examiner reminds the Appellant that the teachings of Falciglia can not be constricted merely to bingo as it was relied on, as detailed above, for its teachings regarding pay tables over a number of hands.

Finally, regarding the Appellant alleging that Falciglia and Schneider teach away from each other, the Examiner respectfully disagrees. The Appellants basis for this claim is that Schneider lets the player pick until they win while Falciglia allows the player only X number of picks. However, the Examiner reminds the Appellant again that the Falciglia reference was used for its teachings regarding basing the award received in the secondary game on the number of tries that it took for all of the predetermined arrangement of criteria to be matched (Column 6, lines 11-23). These payouts are based on a winnings schedule that provides a balance between winning, losing and investing for each spin (Column 6, lines 11-13). The number of limiting factor asserted by the Applicant was not mentioned nor used in the rejection and thus the disclosure for which the references were used do not serve to make them incompatible but conversely, support allowing a player to make a match and basing the score on the number of tries it takes to achieve this hands. The means in which the references were combined, thus, do not make them incompatible as alleged by the Appellant.

As can be seen, the Examiner has provided a proper prima facie case of obvious in denying patentability of the presented claims. The arguments provided by the Appellant are not convincing to overcome the references in the case and thus are not convincing to the Examiner as a means to establish patentability.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

*Christina M. Marks*

Christina M. Marks  
July 1, 2004

Conferees

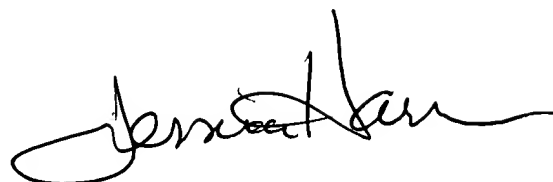
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